

## Remarks

### I. Status of the Application and Claims

As originally filed, the present application had a total of 6 claims. Due to various additions and deletions during prosecution, the claims pending at the time that the present Office Action was issued were 16, 17 and 20, and these claims remain pending.

### II. Submission of Declaration by Dr. Görl

In support of the patentability of the present claims, Applicants submitted, with their previous reply, a Declaration Under 37 C.F.R. § 1.132 by Dr. Udo Görl, one of the inventors named on the above-captioned application.

## The Rejections

### I. Rejection of Claims Under 35 U.S.C. § 102 or 103

On pages 2-3 of the Office Action, the Examiner repeats the same rejections that have been made several times during prosecution. Specifically, claims 16, 17 and 20 are rejected as being anticipated by, or obvious over, Lagarde, *et al.* (U.S. 4,704,425) or Johnson, *et al.* (U.S. 4,681,750).

With regard to Lagarde, the Examiner suggests that (1) intended use does not limit the product claimed; (2) the DBP value is expected to be somewhat higher than the CTAB because DBP is a smaller molecule and thus more readily adsorbed; and (3) Col. 13 teaches a particle size indicative of the claimed product. With regard to Johnson, the examiner repeats arguments (1) and (2).

Moreover, as explained in the paragraph bridging pages 2 and 3, the rejections are based upon the assertion that the previously submitted Declaration of Dr. Görl was not based on a side-by-side comparison, therefore not relevant to patentability. The Examiner also questions why only an indirect comparison was made, rather than a direct comparison between the silicas. It is further suggested that the Declaration did not present new evidence but was merely based on argument.

Applicants respectfully disagree and submit that the evidence of record is relevant and should be considered to overcome the rejections.

Turning first to the last point, namely, that the Declaration is merely based on argument, Applicants respectfully submit that the Examiner has erred in failing to accord the Declaration weight as merely presenting arguments. This is incorrect. The Declaration includes multiple factual and probative statements by the Declarant.

For instance, in paragraph 7, Dr. Görl provides his opinion “as an expert in the field of rubber technology.” Based on his expertise in the field, Dr. Görl explains that the “differences discussed in the [previously filed] Declarations are a direct result of differences in the silicas themselves.”

The Examiner has not explained or addressed why such explanation is not satisfactory to respond to and remove the above-noted criticism that only an “indirect” comparison was made.

In paragraph 8 of his Declaration, Dr. Görl explains why the assertion that the silicas of the references do not inherently satisfy the limitations of the rejected claims is true and correct. The Examiner has not addressed this explanation. Contrary to the assertion that the evidence from paragraph 8 is not relevant because it refers to intended use, this reference to intended use was related only to the question of motivation for modifying the references. Therefore, the Examiner’s criticism is not well taken in this context.

Regarding paragraph 9 of the Declaration, it is there explained that overlapping values of BET, CTAB and BET/CTAB ratio, do not create evidence of inherency (inevitability of result/property/characteristic). The Examiner has not refuted this position which, at a minimum, dictates against retaining at least the rejections under 35 USC §102(b).

In paragraph 10, the Examiner’s treatment of Johnson as anticipating the claimed silicas was noted to be based on an incorrect evaluation of the Johnson disclosure as setting forth a process “that is essentially the same as that used by Applicant.” In maintaining the rejection under at least 35 USC §102(b) the Examiner has not addressed this sound reasoning.

Paragraph 11 of Dr. Görl’s Declaration explains why Lagarde’s disclosure of a particle size of less than 45 microns does not “subsume” or teach “a particle size indicative of the claimed product.” In particular, the failure of the Examiner’s position, again not supported by objective criteria, is evident from the conclusion by Dr. Görl that “the reference not only fails to describe particles with the required sizes but also fails to teach a method which would produce such particles. (emphasis added.) Absent an operative process to make

a claimed product, a reference cannot anticipate (or indeed, make obvious) such claimed product.

Failure to accord due (if any) weight to the declaration evidence which explains the probative values of previously filed declarations and which explains -- based on the declarant's expertise, which has not been refuted -- why the disclosures of the prior art are neither anticipatory nor suggestive of the claimed subject matter, is improper. Reconsideration of the propriety of the Examiner's position with regard to the Declaration and conclusion regarding patentability is, therefore, respectfully requested.

The Examiner is also considered to reconsider the assertion that one skilled in the art would have expected the DBP value to be somewhat higher than the CTAB since DBP is a smaller molecule and, therefore, more readily absorbed.

The Examiner has not provided any basis for this conclusion. Although the cetyl group of CTAB is a longer molecule than the butyl ester groups of DBP, it does not necessarily follow that DBP is a "smaller" molecule expected to be adsorbed more easily. For example, DBP having an aromatic group moiety may be a more bulky molecule, therefore, more difficulty adsorbed.

In any event, the expectation of whether or not DBP or CTAB would be expected to be more easily adsorbed does not inform the inquiry of what the expected value of the DBP/CTAB ratio would be for any given silica.

In this regard, in reconsidering the propriety of the rejections, the Examiner is also requested to again consider the following with regard to Lagarde.

The results of reproducing Example 4 of Lagarde provide the following results:

<u>Parameter</u>	<u>Example 4 value</u>	<u>Range of values, Claim 16</u>
BET-surface area, m <sup>2</sup> /g	200	35-350
CTAB surface area, m <sup>2</sup> /g	207	30-350
BET/CTAB	0.97	0.8-1.1
Pore volume (Hg), ml/g	1.4	1.6-3.4
PV ratio V <sub>2</sub> /V <sub>1</sub> (Hg porosity)	0.62	0.19-0.46
DBP, ml/100 g	210	150-300
DBP/CTAB	1.01	1.2-3.5
Silanol group density, ml	21.6	6-20

The value of DBP/CTAB in Lagarde shows that in the prior art, the adsorption values for DBP and CTAB were essentially the same. Therefore, the higher ratio characterizing the silicas of the present invention are not only evidence of novelty but evidence of an unexpected result.

With regard to the Johnson reference, the Examiner has argued that the process of producing silicas disclosed therein is essentially the same as the process used by Applicants. Again, this is factually incorrect as was explained in the previously filed Declaration(s).

Specifically, the precipitations in the Johnson reference used for preparing silicas are: a) performed at a significantly different pH than Applicants procedure; b) use a multistage, rather than one stage, method; and c) are carried out at a significantly lower solid concentration. Thus, the Examiner's allegation that the silicas disclosed in the reference must be the same as those claimed by Applicants is entirely unjustified.

Unless there is a basis for doubting the objective truth of the assertions made in a Declaration by an expert in a field, the assertions must be accepted. Therefore, it is improper to simply substitute unsupported allegations for the factually based conclusions set forth by an expert. In fact, unsupported allegations should not be used in rejecting claims at all. Applicants therefore respectfully submit that the present rejections have been overcome by the arguments made in the previously filed Declaration. It is therefore respectfully requested that these rejections be withdrawn.

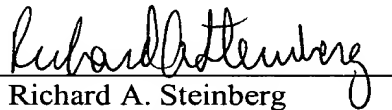
### **Conclusion**

Applicants submit that all of the Examiner's rejections have been overcome. It is therefore respectfully requested that these rejections be withdrawn and that all of the presently pending claims 16, 17 and 20, be allowed.

If, in the opinion of the Examiner, a phone call may help to expedite the prosecution of this application, the Examiner is invited to call Applicants' undersigned attorney at (703) 905-2039.

Respectfully submitted,

PILLSBURY WINTHROP LLP

By:   
Richard A. Steinberg  
Reg. No. 26,588  
Attorneys for Applicant

Date: December 16, 2002  
1600 Tysons Blvd.  
McLean, VA 22102  
Telephone: 703.905.2000; Fax: 703.905.2500  
ARH/RAS:dll